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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,843	12/21/2001	Christopher Robert Carlson	31890/1613	4914

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FOLEY & LARDNER  
321 NORTH CLARK STREET  
SUITE 2800  
CHICAGO, IL 60610-4764

EXAMINER
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NGUYEN, PHONG H

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 05/20/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/036,843

Applicant(s)

CARLSON ET AL.

Examiner

Phong H Nguyen

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/20/04
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-28 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-28 and 30-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9, 12-21, 23-28, 31 and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (3,768,177) in view of Taylor (5,511,472), Rasheed et al. (US Pub. 2002/0009695 A1) and Shimizu et al. (4,562,717).

Regarding claims 1, 2, 12, 13, 17 and 23, Thomas teaches a base 10 with pegs 19 capable of using as a base of an embossing system. See Fig. 1. Taylor teaches an embossing apparatus having an upper template and a lower template. See Figs. 1-5. Therefore, it would have been obvious to rest the templates as taught by Taylor on the base as taught by Thomas so that artists have a stable workplace to hold templates for embossing artworks. It is noted that the Taylor's templates would be rested on the top of backing board 20 in Thomas' base.

Thomas teaches artworks with textures in the background. See Fig. 1. Rasheed et al. teach texture plates for creating textures on artworks. See Fig. 2. Therefore, it would have been obvious to incorporate texture plates as taught by Rasheed et al. to the embossing apparatus as taught by Taylor to create background textures for an artwork. It

is noted that as a user desires to create a background texture for an artwork, he/she would replace the Thomas' backing board 20 by a desired texture plate as taught by Thomas.

Taylor does not teach the size of the upper template and the lower template. Shimizu et al. teach the size of the upper template 2 is slightly larger than the size of the lower template 3 to create a pronounced embossment. See Fig. 10. It is noted that the drawing process and the embossing process are similar since both processes involve in raising a surface of a work piece into bosses. Therefore, it would have been obvious to make the size of the upper template to be slightly larger than the size of the lower template to create a pronounced embossment.

Regarding claims 3 and 27, a scoring tool 18 is best seen in Fig. 2 in Taylor.

Regarding claims 4, 5 and 26, the upper template, the lower template and the texture plate are removably connected to the base.

Regarding claims 6, 18, 19 and 25, the upper and the lower template are hingedly coupled to each other. See Fig. 4 in Taylor.

Regarding claims 7, 14 and 24, a depressed portion of the base 10 is best seen in Fig. 1 in Thomas.

Regarding claims 8, 9, 20, 21, 28 and 31, Taylor does not teach a specific thickness of the upper and the lower template but teaches the effecting of thickness of the templates on the worked paper. See col. 1, lines 20-25. Therefore, it would have been obvious to use templates with appropriate thickness to accommodate worked paper with different thickness or resiliency so that the worked paper would not be stretched beyond its breaking point during the embossing process.

Regarding claim 15, a stylus 19 is best seen in Fig. 2 in Taylor.

Regarding claim 16, Taylor teaches two pegs on the lower template and two holes on the upper templates in order to align the templates together. See Fig. 5. However, as one uses those templates with a base having two pegs for aligning templates as taught by Thomas, it would have been obvious to replace two pegs on the lower templates, as taught by Taylor, by two holes so that both templates can mate with the pegs.

Regarding claims 33-35, Taylor teaches providing a light box to create an outline of the cutout on the paper to be embossed which acts as the guide for the embossing tool. See col. 1, lines 28-32. Therefore, it would have been obvious to provide the base as taught by Thomas a light source in order to create an outline of the cutout on the paper.

3. Claims 10, 11, 22 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (3,768,177) in view of Taylor (5,511,472) and Rasheed et al. (US Pub. 2002/0009695 A1) as applied to claims above, and further in view of Carbone (6,216,354 B1). The combination of Thomas, Taylor and Rasheed does not teach providing grid pattern on the templates. Carbone teaches providing grid pattern 18 and 20 to help orient paper between the templates correctly. See Fig. 1 and col. 2, lines 31-35. Therefore, it would have been obvious to provide grid pattern on the templates as taught by Carbone to help artists orienting paper on the templates correctly.

4. Claims 23, 28-30, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (3,768,177) in view of Geddes (4,309,825).

Regarding claims 23 and 36, Thomas teaches an embossing system comprising a base 10, a texture template 22 and pegs 19. See Fig. 1. Thomas, however, does not teach

templates for embossing a piece of paper. Geddes teaches a first and a second template for embossing a piece of paper. See Fig. 1. Therefore, it would have been obvious to incorporate the Geddes' templates to the Thomas' embossing system so that the background texture can be added to the embossed piece of paper. It is noted that the stencils in Geddes are capable of being used in an embossing process since the embossing process is a process that involves in raising a surface of a work piece into bosses.

Thomas teaches providing pegs 19 to secure templates on the base. Therefore, as the Geddes' templates are used with the Thomas' embossing system, it would have been obvious to provide holes on the Geddes' templates so that they can be secured to the Thomas' embossing system and to be aligned together quickly and easily.

Regarding claims 29 and 37, the size of the shapes on both templates is different. See Fig. 1 in Geddes.

Regarding claims 28 and 30, Geddes does not teach the thickness of the templates. However, it would have been obvious to use templates with appropriate thickness to accommodate worked paper with different thickness or resiliency so that the worked paper would not be stretched beyond its breaking point during the embossing process.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H Nguyen whose telephone number is 703-305-4989. The examiner can normally be reached on Mon-Fri.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PN: 

May 14, 2004

  
Allan N. Shoap  
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